APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,070	10/05/2000	Takeshi Morikawa	018656-186	7739

21839	7590	11/03/2005	

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EXAMINER
POON, KING Y

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/679,070	MORIKAWA ET AL.
	Examiner	Art Unit
	King Y. Poon	2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*17 August 2005*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>*1-17*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>*6*</u> is/are allowed.

6)☒ Claim(s) <u>*1-5 and 7-17*</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>*05 October 2000*</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>*9/19/2005*</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

8/17/2005 and 6/20/2005 has been entered.

2.   The new title filed on 6/20/2005 has been accepted.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1, 2, 7-12, 14, 15-17 are rejected under 35 U.S.C. 103(a) as being

unpatentable over DeHority (US 5,129,639) in view of Nagasaka (US 5,241,349) and

Niikawa (US 4,925,325).

        Regarding claim 1: DeHority teaches a printing system (fig. 1) including a printer

(16, fig. 1) that operates in either a first operating environment (e.g., substitute, column

3, lines 40-45) and a second operating environment (e.g., strict requirement/notify me,

column 3, lines 40-45) that is different from the first operating environment, the printing

system comprising: a print parameter prohibiting means (the information in the control

program, column 2, lines 65-68, that determines a mismatch, column 4, lines 20-25) that

prohibits use of a printing parameter (e.g., a duplex requirement, column 4, lines 5-6)

associated with a print job (column 3, line 23); a parameter determiner (the software

that determines print job requirement that is mismatched, column 3,lines 29-40, fig. 2A,

fig. 2B) that receives a print job and determines whether a printing parameter to be used

in the print job is prohibited by the print parameter prohibiting means; and a controller

(20, fig. 1) that, when the parameter determiner determines that a printing parameter is

prohibited (mismatch at 62, fig. 2B) prohibits processing of the print job (the print job is

processed with a substitute parameter, not the prohibited print parameter, column 4,

lines 30-40) using the print parameter prohibited.

DeHority does not teach the printer is operating in an on-line mode.

Niikawa, in the same area of printer, teaches it is well known in the art to provide

an on-line mode such that the printer is communicating with a host and a off-line mode

such that the printer is not used to communicate with the host (column 3, lines 24-30).

Therefore, it would have been obvious to a person with ordinary skill in the art at

the time the invention was made to have modified DeHority to include: an on-line mode

such that user is allowed to control the communication between the host computer and

the conventional printer of Dehority, column 2, lines 44-50.

DeHority also does not teach an operating environment detector that determines whether the printer operating environment is a first environment being a first period of time or a second environment being a second time period, the second time period is not overlapping with the first time period.

Nagasaka, in the same area of printer (column 10, lines 23-27), it is well known in the art to provide printer with: an operating environment detector that determines whether the printer operating environment is a first environment being a first period of time or a second environment being a second time period, the second time period is not overlapping with the first time period (fig. 4, column 10, lines 17-22), such that power is being conserved.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority to include: an operating environment detector that determines whether the printer operating environment is a first environment being a first period of time or a second environment being a second time period, the second time period is not overlapping with the first time period.

Note: after the modification of DeHority, the printer receiving print job from the host must be in the on-line mode and the processing of the print job of using a prohibited parameter must be prohibited in both detected periods of time which includes first period of time.

Regarding claim 2: DeHority teaches wherein the controller forcibly cancels the printing parameter that is prohibited and changes the parameter to another available printing parameter to perform the print job (column 4, line 31).

Regarding claim 7: Nagasaka teaches a designated that designates the first operating environment and the second operating environment (column 9, lines 12-25).

Regarding claim 8: Nagasaka teaches wherein the designator designates a time period (column 9, lines 12-25, column 10, lines 17-22, column 6, lines 40-43).

Regarding claim 9: Nagasaka teaches wherein the operating environment detector determines environment based on environment of network (the time zone of the network, fig. 4) to which the printer is connected.

Regarding claim 10: DeHority teaches wherein the print parameter prohibiting means operates according to a detection detected by a sensor (the device in the processor that sense the right signal is called for, column 8, lines 13-15) located in the printer (16, fig. 1).

Regarding claim 11: DeHority teaches wherein the print parameter prohibiting means operates by a manual operation (a user/operator sets the printer configuration, column 4, lines 20-25; i.e., a user determines what is available in the printer) by a user.

Regarding claim 12: DeHority teaches wherein the print parameter prohibiting means is located in the printer (column 2, lines 50-69).

Regarding claim 14: DeHority teaches A print job management method of a printing system including a printer (16, fig. 1) that operates in either a first operating environment (e.g., substitute, column 3, lines 40-45) and a second operating environment (e.g., strict requirement/notify me, column 3, lines 40-45) that is different from the first operating environment, comprising steps of: setting a prohibit printing parameter (e.g., a duplex requirement, column 4, lines 5-6, associated with a print job

cannot be performed by the printer, 46, fig. 2A) associated with a print job; determining

(determining mismatch, fig. 2A, fig. 2B) whether a printing parameter to be used in the

print job is prohibited; and prohibiting processing of the print job (the print job is

processed with a substitute parameter, not the prohibited print parameter, column 4,

lines 30-40) using the print parameter prohibited, when the determining step determines

that a printing parameter is prohibited (mismatch 62, fig. 2B) and the detecting step

detects that the environment is the first operating environment (best at 72, fig. 2B).

DeHority does not teach the printer is operating in an on-line mode.

Niikawa, in the same area of printer, teaches it is well known in the art to provide

an on-line mode such that the printer is communicating with a host and a off-line mode

such that the printer is not used to communicate with the host (column 3, lines 24-30).

Therefore, it would have been obvious to a person with ordinary skill in the art at

the time the invention was made to have modified DeHority to include: an on-line mode

such that user is allowed to control the communication between the host computer and

the conventional printer of Dehority, column 2, lines 44-50.

DeHority also does not teach an operating environment detector that determines

whether the printer operating environment is a first environment being a first period of

time or a second environment being a second time period, the second time period is not

overlapping with the first time period.

Nagasaka, in the same area of printer (column 10, lines 23-27), it is well known

in the art to provide printer with: an operating environment detector that determines

whether the printer operating environment is a first environment being a first period of

time or a second environment being a second time period, the second time period is not overlapping with the first time period (fig. 4, column 10, lines 17-22), such that power is being conserved.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority to include: an operating environment detector that determines whether the printer operating environment is a first environment being a first period of time or a second environment being a second time period, the second time period is not overlapping with the first time period.

Note: after the modification of DeHority, the printer receiving print job from the host must be in the on-line mode and the processing of the print job of using a prohibited parameter must be prohibited in both detected periods of time which includes first period of time.

Regarding claim 15: DeHority teaches a printing system (fig. 1) including a printer, (16, fig. 1) comprising: an operating environment setting means (user's computer, column 3, lines 40-50, 10, fig. 1) that sets a first operating environment (e.g., substitute, column 3, lines 40-45) as the operating environment for the printer, as well as a second operating environment (e.g., strict requirement/notify me, column 3, lines 40-45) that is different from the first operating environment; a print parameter prohibiting means (the information in the control program, column 2, lines 65-68, that determines a mismatch, column 4, lines 20-25) that prohibits use of a printing parameter (e.g., a duplex requirement, column 4, lines 5-6) associated with a print job (column 3, line 23); a parameter determiner (the software that determines print job requirement that is

mismatched, column 3,lines 29-40, fig. 2A, fig. 2B) that determines whether or not a

printing parameter of a print job is prohibited by the print parameter prohibiting means;

and a controller (20, fig. 1) that, when the parameter determiner determines that a

printing parameter is prohibited (mismatch at 62, fig. 2B), executes a different print

mode (the print job is processed with a substitute parameter, not the prohibited print

parameter, column 4, lines 30-40) based on the determination by the operating

environment detector (determines that best is to be used, 72, fig. 2B).

DeHority does not teach the printer is operating in an on-line mode.

Niikawa, in the same area of printer, teaches it is well known in the art to provide

an on-line mode such that the printer is communicating with a host and a off-line mode

such that the printer is not used to communicate with the host (column 3, lines 24-30).

Therefore, it would have been obvious to a person with ordinary skill in the art at

the time the invention was made to have modified DeHority to include: an on-line mode

such that user is allowed to control the communication between the host computer and

the conventional printer of Dehority, column 2, lines 44-50.

DeHority also does not teach an operating environment detector that determines

whether the printer operating environment is a first environment being a first period of

time or a second environment being a second time period, the second time period is not

overlapping with the first time period.

Nagasaka, in the same area of printer (column 10, lines 23-27), it is well known

in the art to provide printer with: an operating environment detector that determines

whether the printer operating environment is a first environment being a first period of

time or a second environment being a second time period, the second time period is not overlapping with the first time period (fig. 4, column 10, lines 17-22), such that power is being conserved.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority to include: an operating environment detector that determines whether the printer operating environment is a first environment being a first period of time or a second environment being a second time period, the second time period is not overlapping with the first time period.

Note: after the modification of DeHority, the printer receiving print job from the host must be in the on-line mode and the processing of the print job of using a prohibited parameter must be prohibited in both detected periods of time which includes first period of time. DeHority teaches print job is not to be executed if a print parameter is prohibited (74, 78, fig. 2B). Nagasaka teaches executes a different print mode based on the determination by the environment detector (fig. 4) if there are no print job to be executed.

Regarding claims 16, 17: Nagasaka teaches designating the first operating environment and the second operating environment (column 6, lines 40-45).

5.   Claims 3, 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeHority and Nagasaka as applied to claim 1 above, and further in view of Tang et al (US 6,160,629).

Regarding claim 3: DeHority does not teach the controller forcibly deletes the print job including the printing parameter that is prohibited.

Tang, in the same area of printing, teaches deleting print job (note; a print job includes printing parameter) (column 4, lines 50-55).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority's printing system to include: the controller forcibly deletes the print job including the printing parameter prohibited.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority's printing system by the teaching of Tang because of the following reasons: (a) it would have prevented the printer from running out of memory; and (b) it would have allowed the printer to function properly by having enough memories to store other useful print jobs.

Regarding claim 4: DeHority does not teach the controller goes on keeping the print job including the printing parameter that is prohibited.

Tang, in the same area of printing, teaches keeping a print job (note; a print job includes printing parameter) (column 4, lines 37-40).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority's printing system to include: the controller goes on keeping the print job including the printing parameter that is prohibited.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority's printing system by the teaching of Tang because of the following reasons: (a) it would have allowed the print job to be printed in the future, as taught by Tang at column 4, lines 37-40; and (b) it would have

allowed the print job to be printed when the printer is configured to print the prohibited

parameters in the future (column 4, lines 20-25, DeHority).

Regarding claim 5: DeHority teaches where a printing parameter is determined

by the parameter determiner (the software that determines print job requirement that is

mismatched, column 3,lines 29-40, fig. 2A, fig. 2B) to be prohibited the controller notifies

a warning message (column 4, lines 25-27).

DeHority does not teach to display the warning message.

Tang, in the same area of printing, teaches it is well known to convey a message

to a person is by displaying (column 5, lines 25-30).

Therefore, it would have been obvious to a person with ordinary skill in the art at

the time the invention was made to have modified DeHority's printing system to include:

display the warning message.

It would have been obvious to a person with ordinary skill in the art at the time

the invention was made to have modified DeHority's printing system by the teaching of

Tang because of the following reasons: (a) it would have provided a fast and reliable

way of sending the warning message to the operator.

6.   Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeHority

as applied to claim 1 above, and further in view of Hower, Jr. et al. (US 5,467,434).

Regarding claim 13: DeHority does not teach wherein the print parameter

prohibiting means is a program installed in a computer that transfer the print job to the

printer.

Hower, in the same area of print parameter prohibiting, teaches a print parameter

prohibiting program (37, fig. 2, column 7, lines 25-55) that is installed in a computer (15-

1, fig. 2) that transfer the print job to a printer (column 3, lines 35-50).

Therefore, it would have been obvious to a person with ordinary skill in the art at

the time the invention was made to have modified DeHority's printing system to include:

wherein the print parameter prohibiting means is a program installed in a computer that

transfer the print job to the printer.

It would have been obvious to a person with ordinary skill in the art at the time

the invention was made to have modified DeHority's printing system by the teaching of

Hower, Jr. et al. because of the following reasons: (a) it would have reduced the work

load of the printer processor such that the printer processor would allocate more time to

process the print job to speed up the printing process; and (b) it would have increase

the usable life of the printer/processor by reducing the work load of the printer.

Allowable Subject Matter

7.   Claim 6 is allowed.

Response to Arguments

8.   Applicant's arguments filed 8/17/2005 have been fully considered but they are

not persuasive.

With respect to applicant's argument that DeHority does not teach detecting a first time period and a second time period, the first time period does not overlap the second time period, has been considered.

In reply: DeHority does not teach an operating environment detector that determines whether the printer operating environment is a first environment being a first period of time or a second environment being a second time period, the second time period is not overlapping with the first time period.

Nagasaka, in the same area of printer (column 10, lines 23-27), it is well known in the art to provide printer with: an operating environment detector that determines whether the printer operating environment is a first environment being a first period of time or a second environment being a second time period, the second time period is not overlapping with the first time period (fig. 4, column 10, lines 17-22), such that power is being conserved.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified DeHority to include: an operating environment detector that determines whether the printer operating environment is a first environment being a first period of time or a second environment being a second time period, the second time period is not overlapping with the first time period.
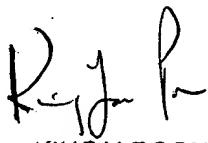
Note: after the modification of DeHority, the printer receiving print job from the host must be in the on-line mode and the processing of the print job of using a prohibited parameter must be prohibited in both detected periods of time which includes first period of time.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KING Y. POON
PRIMARY EXAMINER

10/25/05